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<b>TRANSMITTAL FORM</b> (to be used for all correspondence after initial filing)		Application No.	09/405,826
		Filing Date	September 24, 1999
		First Named Inventor	Annette Wagner
		Group Art Unit	2685
		Examiner Name	Temica M. Davis
Total Number of Pages in This Submission	65	Attorney Docket Number	82225P2813D3

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Firm or Individual name	Eric S. Hyman, Reg. No. 30,139 BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Signature	
Date	October 4, 2002

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<b>FEE TRANSMITTAL</b> <b>for FY 2002</b> <small>Patent fees are subject to annual revision.</small>		<b>Complete if Known</b>	
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27.		Application Number	09/405,826
		Filing Date	September 24, 1999
		First Named Inventor	Annette Wagner
		Examiner Name	Temica M. Davis
		Group/Art Unit	2685
<b>TOTAL AMOUNT OF PAYMENT</b> (\$) 320.00		Attorney Docket No.	82225P2813D3

<b>METHOD OF PAYMENT (check one)</b> <input checked="" type="checkbox"/> Check <input type="checkbox"/> Credit card <input type="checkbox"/> Money Order <input type="checkbox"/> Other <input type="checkbox"/> None <input type="checkbox"/> Deposit Account Deposit Account Number: 02-2666 Deposit Account Name: Blakely, Sokoloff, Taylor & Zafman LLP The Commissioner is authorized to: (check all that apply) <input type="checkbox"/> Charge fee(s) indicated below <input checked="" type="checkbox"/> Credit any overpayments <input checked="" type="checkbox"/> Charge any additional fee(s) required under 37 CFR §§ 1.16, 1.17, 1.18 and 1.20. <input type="checkbox"/> Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account	<b>FEE CALCULATION (continued)</b> <b>3. ADDITIONAL FEES</b> <table border="1" style="width:100%; border-collapse: collapse;"> <thead> <tr> <th colspan="2">Large Entity</th> <th colspan="2">Small Entity</th> <th rowspan="2">Fee Description</th> <th rowspan="2">Fee Paid</th> </tr> <tr> <th>Fee Code</th> <th>Fee (\$)</th> <th>Fee Code</th> <th>Fee (\$)</th> </tr> </thead> <tbody> <tr> <td>105</td> <td>130</td> <td>205</td> <td>65</td> <td>Surcharge - late filing fee or oath</td> <td></td> </tr> <tr> <td>127</td> <td>50</td> <td>227</td> <td>25</td> <td>Surcharge - late provisional filing fee or cover sheet.</td> <td></td> </tr> <tr> <td>139</td> <td>130</td> <td>139</td> <td>130</td> <td>Non-English specification</td> <td></td> </tr> <tr> <td>147</td> <td>2,520</td> <td>147</td> <td>2,520</td> <td>For filing a request for ex parte reexamination</td> <td></td> </tr> <tr> <td>112</td> <td>920 *</td> <td>112</td> <td>920 *</td> <td>Requesting publication of SIR prior to Examiner action</td> <td></td> </tr> <tr> <td>113</td> <td>1,840 *</td> <td>113</td> <td>1,840 *</td> <td>Requesting publication of SIR after Examiner action</td> <td></td> </tr> <tr> <td>115</td> <td>110</td> <td>215</td> <td>55</td> <td>Extension for reply within first month</td> <td></td> </tr> <tr> <td>116</td> <td>400</td> <td>216</td> <td>200</td> <td>Extension for reply within second month</td> <td></td> </tr> <tr> <td>117</td> <td>920</td> <td>217</td> <td>460</td> <td>Extension for reply within third month</td> <td></td> </tr> <tr> <td>118</td> <td>1,440</td> <td>218</td> <td>720</td> <td>Extension for reply within fourth month</td> <td></td> </tr> <tr> <td>128</td> <td>1,960</td> <td>228</td> <td>980</td> <td>Extension for reply within fifth month</td> <td></td> </tr> <tr> <td>119</td> <td>320</td> <td>219</td> <td>160</td> <td>Notice of Appeal</td> <td>320.00</td> </tr> <tr> <td>120</td> <td>320</td> <td>220</td> <td>160</td> <td>Filing a brief in support of an appeal</td> <td></td> </tr> <tr> <td>121</td> <td>280</td> <td>221</td> <td>140</td> <td>Request for oral hearing</td> <td></td> </tr> <tr> <td>138</td> <td>1,510</td> <td>138</td> <td>1,510</td> <td>Petition to institute a public use proceeding</td> <td></td> </tr> <tr> <td>140</td> <td>110</td> <td>240</td> <td>55</td> <td>Petition to revive - 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late filing fee or oath		127	50	227	25	Surcharge - late provisional filing fee or cover sheet.		139	130	139	130	Non-English specification		147	2,520	147	2,520	For filing a request for ex parte reexamination		112	920 *	112	920 *	Requesting publication of SIR prior to Examiner action		113	1,840 *	113	1,840 *	Requesting publication of SIR after Examiner action		115	110	215	55	Extension for reply within first month		116	400	216	200	Extension for reply within second month		117	920	217	460	Extension for reply within third month		118	1,440	218	720	Extension for reply within fourth month		128	1,960	228	980	Extension for reply within fifth month		119	320	219	160	Notice of Appeal	320.00	120	320	220	160	Filing a brief in support of an appeal		121	280	221	140	Request for oral hearing		138	1,510	138	1,510	Petition to institute a public use proceeding		140	110	240	55	Petition to revive - unavoidable		141	1,280	241	640	Petition to revive - unintentional		142	1,280	242	640	Utility issue fee (or reissue)		143	460	243	230	Design issue fee		144	620	244	310	Plant issue fee		122	130	122	130	Petitions to the Commissioner		123	50	123	50	Processing fee under 37 CFR 1.17(q)		126	180	126	180	Submission of Information Disclosure Stmt		581	40	581	40	Recording each patent assignment per property (times number of properties)		146	740	246	370	Filing a submission after final rejection (37 CFR § 1.129(e))		149	740	249	370	For each additional invention to be examined (37 CFR § 1.129(b))		179	740	279	370	Request for Continued Examination (RCE)		169	900	169	900	Request for expedited examination of a design application	
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<b>1. BASIC FILING FEE</b>		<b>2. EXTRA CLAIM FEES</b>		<b>3. SUBTOTALS</b>	
Large Entity	Small Entity	Total Claims	Extra Claims	Fee from below	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
101	740	201	370	Utility filing fee	
106	330	205	165	Design filing fee	
107	510	207	255	Plant filing fee	
108	740	208	370	Reissue filing fee	
114	160	214	80	Provisional filing fee	
<b>SUBTOTAL (1)</b> (\$)		15 - 42 = 0 X 18.00 = \$0.00 4 - 9 = 0 X 84.00 = \$0.00 Multiple Dependent =		<b>SUBTOTAL (2)</b> (\$) 0.00	

<b>1. BASIC FILING FEE</b>		<b>2. EXTRA CLAIM FEES</b>		<b>3. SUBTOTALS</b>	
Large Entity	Small Entity	Total Claims	Extra Claims	Fee from below	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
103	18	203	9	Claims in excess of 20	
102	84	202	42	Independent claims in excess of 3	
104	280	204	140	Multiple Dependent claim, if not paid	
109	84	209	42	**Reissue independent claims over original patent	
110	18	210	9	**Reissue claims in excess of 20 and over original patent	
<b>SUBTOTAL (2)</b> (\$) 0.00		<b>SUBTOTAL (3)</b> (\$) 320.00		<b>WARNING:</b> Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2039.	

<b>4. SUBMITTED BY</b>		<b>5. COMPLETE (if applicable)</b>	
Name (Print/Type)	Eric S. Hyman	Registration No. (Attorney/Agent)	30,139
Signature		Telephone	(310) 207-3800
		Date	10/04/02



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10/16/02  
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PATENT  
Attorney's Docket No. 82225P2813D3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Annette Wagner et al.

Serial No. 09/405,826

Filed: September 24, 1999

For: GRAPHICAL USER INTERFACE  
FOR A PORTABLE TELEPHONE

Examiner: Temica M. Davis

Art Group: 2685

Box AF  
Commissioner for Patents  
Washington, D.C. 20231

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APPEAL BRIEF

Dear Sir:

Applicants (hereinafter "Appellants") submit, in triplicate, the following Appeal Brief pursuant to 37 C.F.R. § 1.192 for consideration by the Board of Patent Appeals and Interferences. Appellants also submit herewith a check in the amount of \$320.00 to cover the cost of filing the opening brief as required by 37 C.F.R. § 1.17(f). Please charge any additional amount due or credit any overpayment to deposit Account No. 02-2666.

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## **I. REAL PARTY IN INTEREST**

Annette Wagner, Jeffrey Herman, Herbert Jellinek and Susan Booker, the parties named in the caption, assigned their rights to the invention disclosed in the subject application through an Assignment recorded on September 28, 1999 at reel and frame 010267/0528 to Sun Microsystems, Inc., 4120 Network Circle, Santa Clara, CA 95054. Therefore, Sun Microsystems, Inc. is the real party in interest.

## **II. RELATED APPEALS AND INTERFERENCES**

There are no other appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in this Appeal.

## **III. STATUS OF CLAIMS**

Claims 35-49 and 53-56 are pending in the application. The Examiner has rejected claims 35-49 and 53-56. Appellants appeal the rejection of claims 35-49 and 53-56.

## **IV. STATUS OF AMENDMENTS**

No amendments were filed subsequent to the final rejection.

## **V. SUMMARY OF THE INVENTION**

The embodiments of the invention provide an apparatus and method for a graphical user interface for portable telephones. The graphical user interface (GUI) provides access to a universal mailbox for storing both electronic mail and voicemail messages that can be accessed by users through the universal mailbox which displays both types of messages on the same display screen.

See specification of Appellants, page 12, line 15 to page 13, line 10. The GUI includes a reply feature that allows the user to initiate an outgoing reply to either type of received message with a touch of button. See specification of Appellants, page 13, line 11 to page 14, line 16. The GUI allows a user to reply to stored messages. When a user selects a message to respond to, an appropriate reply mode is automatically entered into based on the source of the message. See specification of Appellants, page 13, line 11- page 14, line 16. Further, the GUI software enables automatic selection of a form to be used for a reply message based upon the content of displayed information at the time the user makes an input after previously requested data has been received. See specification of Appellants, page 17, lines 6-line 22. Also, the GUI software enables the monitoring of incoming data for predetermined content and when that content is detected, the software enters into a mode automatically for the user to transmit a message. See specification of Appellants, page 17, lines 6-22.

## **VI. ISSUES**

The issues involved in this Appeal are as follows:

A. Are claims 35-49 and 53-56 unpatentable over U.S. Patent No. 5,797,089 issued to Nguyen ("hereinafter Nguyen") in view of U.S. Patent No. 5,875,403 issued to Christal (hereinafter "Christal").

B. Are claims 35-49 and 53-56 unpatentable based on the judicially created doctrine of obviousness type double patenting over claims 1-14 of U.S. Patent No. 6,169,911 issued to Wagner, et al. (hereinafter "Wagner '911").

## **VII. GROUPING OF CLAIMS**

Appellants submit that the claims do not stand or fall together. Appellants contend that the claims can be divided into the following groups and each group is separately patentable:

Group I - Claims 35, 37, 44 and 47

Group II - Claims 36, 45 and 48

Group III - Claims 38, 42 and 53

Group IV - Claims 39 and 54

Group V - Claim 40

Group VI - Claims 41 and 55

Group VII - Claims 43, 46 and 49

Group VIII - Claim 56

The reasons for the independent patentability of the separate groups is discussed in detail below.

## **VIII. ARGUMENTS**

The Examiner has rejected claims 35-49 and 53-56 under 35 U.S.C. §103(a) as unpatentable over Nguyen (U.S. Patent No. 5,797,089) in view of Christal (U.S. Patent No. 5,875,403) and has rejected claims 35-49 and 53-56 under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-14 of Wagner '911 (U.S. Patent No. 6,169,911).

### **A. Overview of the Prior Art**

#### **1. Overview of Nguyen**

Nguyen teaches a personal communications terminal that combines a mobile telephone unit with a personal digital assistant (PDA). Nguyen, col. 3, lines 1-3. A component of Nguyen enables a user to make a call using addresses stored in a personal digital assistant portion of the device. Nguyen, col. 5, lines 46-68. Nguyen also teaches a text editor for composing messages that may be either sent by facsimile wherein the user selects a fax application after composing a message and then chooses a telephone number to which the messages is to be transmitted or sent by short message service (SMS) which involves selecting

an SMS application of the PDA, selecting a telephone number and pressing a key to transmit the SMS message. See Nguyen, col. 6, lines 1-34.

Nguyen does not teach the automatic selection of a form based upon the currently displayed information or entering a mode allowing a user to transmit a message upon detecting a predetermined content within previously requested incoming information.

## **2. Overview of Christal**

Christal teaches a mobile telephone that can receive SMS messages.

Christal, col. 2, lines 15-19. In response to a received SMS message, a user can send a "YES" reply message by pressing first the 'OPTION' button and subsequently a 'YES' button, and finally a 'SEND MESSAGE' button. See col. 2, lines 23-37. Alternatively, a message produced entirely by the user can be sent in response to the received message by pressing an 'OPTION' button and an 'EDIT' button while viewing the message then composing a message and finally pressing a 'SEND' button. See col. 2, lines 37-47.

Christal does not teach automatically selecting a form for a message to be transmitted based on the content of displayed information at the time user input initiates a transmission mode. Christal also does not teach monitoring the content of data being received for predetermined content and upon detecting the predetermined content, entering a mode allowing the user to transmit a message.

### **B. Rejection of Group I under 35 U.S.C. §103(a) as Obvious over Nguyen in view of Christal**

To establish a *prima facie* case for obviousness it must be shown that the cited references teach or suggest each element of the claim. See *In Re Reinhart*, 189 U.S.P.Q. 143, 147 CCPA, 1976 ('*prima facie*' case of obviousness is established where the teachings from the prior art itself would appear to have suggested the claimed subject matter"). In regard to



claim 35, 44 and 47, these claims include the element of "in response to a user input initiating a transmission mode, automatically selecting a form for a message to be transmitted based on a content of a displayed information at the time that user input is received." Claim 35, lines 7-9. Neither Nguyen nor Christal teach these elements of claims 35, 44 and 47. Nguyen teaches a device capable of receiving short message service (SMS) messages which includes a text editor to edit messages to be sent in the SMS format. See Nguyen, col. 6, lines 17-34. Nguyen does not teach the use of a form in connection with messaging and thus does not teach or suggest selecting a form based on the content of information being displayed at the time the user input that initiated the transmission mode was received. The Examiner has not identified any part of Nguyen that teaches entering a transmission mode upon receiving a user input and in the process automatically selecting a form for a message to be transmitted based on content displayed at the time the transmission mode was initiated. Rather, the Examiner admits in Paper No. 9 under paragraph 4 that Nguyen does not specifically disclose use of automatically entering a reply mode when a message is selected." Instead, the Examiner relies on Christal for teaching these elements of claims 35, 44 and 47. However, Christal does not cure the defects of Nguyen.

Christal teaches a device that provides two options for responding to SMS messages. The first option for responding to SMS messages taught by Christal is sending back a preset "YES" message when viewing a message by pressing sequentially an 'OPTION' button, a 'YES' button and finally a 'SEND' button to send the message. See Christal, col. 2, lines 29-34 and Figure 4. A second option while viewing a received message is to press the 'OPTION' button and then to press an 'EDIT' button which opens an editor that allows the creation of a return message using a key pad and then the message can be sent by pressing the 'SEND' button. See Christal, col. 2, lines 34-47. Neither of these two manners of responding to a message taught by Christal involve the automatic selection of a form for a message to be transmitted based on the content of a displayed information at the time that the transmission mode was initiated by user input. All the contents of the messages generated for

reply taught by Christal are a result of direct user selection (i.e., sending a "YES" message by pressing a sequence of buttons or composing a message on a key pad). Thus, Christal does not teach an automated selection of a form based on the content of displayed information. Therefore, Nguyen combined with Christal does not teach each of the elements of claims 35, 44 and 47.

In regard to claim 37, this claim depends from independent claim 35 and incorporates the limitations thereof. Thus, at least for the reasons mentioned in regard to claim 35, this claim is not obvious over Nguyen in view of Christal. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claims 34, 37, 44, and 47. Accordingly, it is requested that the obviousness rejection of Group I be overturned.

**C. Rejection of Group II under 35 U.S.C § 103(a) as Obvious over Nguyen in view of Christal**

In regard to claims 36, 45 and 48, these claims depend from independent claims 35, 44 and 47, respectively. Thus, at least for the reasons mentioned in regard to independent claims 35, 44 and 47, these claims are not obvious over Nguyen in view of Christal. These claims are also independently patentable for the following reasons.

Claims 36, 45 and 48 include the elements of "automatically selecting a form for an outgoing electronic mail message based on the content of the displayed information at the time the user input is received." As discussed in regard to Group I, the Examiner has not identified any part of Nguyen that teaches automatically selecting a form upon entering a transmission mode after receiving a user input. Christal does not cure the defects of Nguyen for the reasons mentioned in regard to Group I. Further, Christal teaches only the handling of SMS messages. Thus, neither Nguyen nor Christal teach selecting a form for an outgoing *electronic mail* message. An electronic mail message form is not restricted to the 160 characters that SMS messages are restricted to. A form designed for use with an SMS message will only include space for the 160 characters and the phone address of the recipient. An electronic mail message can handle an indefinite number of

characters and includes additional header information including the recipients email address, a subject line and carbon copy and blind carbon copy recipient fields. Thus, selecting a form for an electronic mail message necessarily requires additional analysis of a display context in order to select an appropriate form. See specification of Appellants, page 12, lines 22-23 and page 13 line 23 - page 14, line 16. The Examiner has not indicated any part of Nguyen or Christal that teaches the selection of an electronic mail form based on displayed information, or any part of the cited references that teach or suggest the analysis necessary to choose such a form. Thus, Nguyen in view of Christal does not teach each of the elements of claims 36, 45 and 48. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claims 36, 45 and 48. Further, these claims are separately patentable because they include the additional limitation of selecting a form for an electronic mail message. Accordingly, it is requested that the obviousness rejection of Group II be overturned.

**D. Rejection of Group III under 35 U.S.C § 103(a) as Obvious over Nguyen in View of Christal**

With respect to Group III, the Examiner has failed to establish a *prima facie* case of obviousness. In regard to claims 38 and 53, the claims include the elements of "monitoring the content of the data for a predetermined content" as the data is received and "in response to detecting a predetermined content automatically entering a mode for allowing a user to transmit a message from the telephone." See claim 38, lines 4-6. The Examiner admits in Paper No. 9, that Nguyen does not specifically disclose automatically entering a reply mode when a message is selected. Thus, Nguyen does not teach monitoring data being received and when predetermined content is detected automatically entering a mode to allow a user to transmit a message. Christal does not cure this defect of Nguyen. The Examiner has not identified any part of Christal that teaches entering a mode to transmit a message upon detecting predetermined content in data being received from a remote source as claimed in claims 38 and 53.

Further, the Examiner mischaracterizes Figure 4 of Christal as teaching an automatic entry to reply mode "if the user does not wish to create a return message with the keyboard, at the end of any incoming message." Page 6 of Paper No. 9. However, the Examiner does not indicate where in Christal this is taught. As discussed in regard to claim 35, Christal teaches two means for replying to received messages both at least involve the action of a user to press an 'OPTION' button. See Figure 4, Figure 2, and col. 2, lines 29-32 and lines 38-41. Figure 2 and 4 clearly illustrate that a user must push an 'OPTIONS' button before either a "YES" message can be selected or an edit mode is selected. The Examiner has failed to indicate any part of Christal or Nguyen that teaches or suggests a reply mode is *automatically* entered in response to detecting predetermined content. The Examiner has ignored the claim language in claims 38 and 53 relating to detecting predetermined content and has ignored the claimed relationship between entering a replay mode and detecting predetermined content. Thus, Christal does not teach an automatic entry into reply mode because user input is required by Christal to initiate a reply to a message. Nguyen combined with Christal does not teach entering a mode for transmitting a message automatically upon detecting a predetermined content in the received data. Thus, Nguyen, in view of Christal does not teach each element of claims 38 and 53. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness.

In regard to claim 42, this claim depends from independent claim 38 and incorporates the limitations thereof. Thus, at least for the reasons mentioned in regard to claim 38, this claim is not obvious over Nguyen in view of Christal. Accordingly, Group III is separately patentable and it is requested that the obviousness rejection of Group III be overturned.

E. **Rejection of Groups IV and VIII under 35 U.S.C § 103(a) as Obvious over Nguyen in View of Christal**

With respect to Groups IV and VIII, the Examiner has failed to establish a *prima facie* case of obviousness. In respect to claims 39 and 54, these claims depend from independent claims 38 and 53 and incorporate the limitations thereof. In regard to claim 56, this claim has

many of the same elements as claims 38 and 53 including the elements of a control circuit configured to "detect predetermined content in the non-voice data" being received from a remote source, and a control circuit being configured to "enter transmission mode for allowing a user to transmit an electronic mail message in response to detecting the predetermined content." Thus, for the reasons mentioned in regard to claims 38 and 53, these claims are not obvious over Nguyen in view of Christal. Specifically, the Examiner has failed to indicate where Nguyen and Christal teach monitoring incoming information and in response to detecting a predetermined content entering a reply mode. In addition, claims 39, 54 and 56 are separately patentable for the following reasons.

Claims 39, 54 and 56 include the elements of automatically selecting a message to be transmitted in response to detecting the predetermined content. See claim 56, lines 8 and 9. Neither Nguyen nor Christal teaches detecting a predetermined content in data being received and thus do not teach automatically selecting a message to be transmitted in response to detecting the predetermined content. The Examiner has not identified any part of Nguyen or Christal that teaches or suggests these elements of claims 39, 54, and 56. Therefore, Nguyen, in view of Christal does not teach each of the elements of claims 39, 54 and 56. These claims are separately patentable at least because they include the element of automatically selecting a message as a response to detecting predetermined contact. These claims differ from Group III in that they include the elements of selecting a message as a response which requires the identifying of an appropriate response to predetermined data. Claims 39, 54 and 56 combine several elements from the claims of Group III and Group I not claimed in combination in those Groups. Accordingly, the claims of Groups IV and VIII are separately patentable and it is requested that the obviousness rejections of Group IV and VIII be overturned.

F. **Rejection of Group V under 35 U.S.C § 103(a) as Obvious over  
Nguyen in View of Christal**

With respect to Group V, the Examiner has failed to establish a *prima facie* case of obviousness. In respect to claim 40, this claim depends from independent claim 38 and incorporates the limitations thereof. Thus, at least for the reasons mentioned in regard to claim 38, this claim is not obvious over Nguyen in view of Christal. Further, claim 40 is separately patentable for the following reasons.

Claim 40 includes the elements of "automatically selecting a format of the message to be transmitted in response to detecting the predetermined content." See claim 40, lines 3 and 4. The Examiner has failed to identify any part of Nguyen or Christal that teaches or suggests the automatic selection of the format of a message to be transmitted in response to detecting predetermined content. Neither Christal nor Nguyen teach or suggest monitoring for predetermined content as discussed in regard to claim 38. Claim 40 combines this with the selection of a format of response message requiring the identification of the format, source, type of the incoming data containing the predetermined content and initiating a response using the appropriate format. See specification of Appellants, page 17, line 6-22. Thus, each of the elements of claim 40 are not taught by Nguyen in view of Christal. Therefore, the Examiner has failed to carry his burden of establishing a *prima facie* case of obviousness. Claim 40 is patentably distinct because it combines the elements of claim 38, including detecting predetermined content with the additional elements of selecting an appropriate format for a response message automatically initiated upon the detection of the predetermined content. Accordingly, claim 40 is separately patentable and it is requested that the obviousness rejection of Group V be overturned.

G. **Rejection of Group VI under 35 U.S.C § 103(a) as Obvious over  
Nguyen in View of Christal**

With respect to Group VI, the Examiner has failed to make a *prima facie* case of obviousness. In regard to claims 41 and 55, these claims depend from independent claims 38 and

53 and incorporate the limitations thereof. Thus, at least for the reasons mentioned in regard to claims 38 and 53, these claims are not obvious over the cited references. Further, claims 41 and 55 are separately patentable for the following reasons.

Claims 41 and 55 include the element of "automatically selecting a form for an outgoing electronic mail message in response to detecting the predetermined content." See claim 41, lines 5 and 6. As discussed in regard to Group III, neither Nguyen nor Christal teach or suggest automatically entering a transmission mode for allowing a user to transmit a message from a phone. See claim 38, lines 5 and 6. Also, as discussed in regard to Group I, neither Nguyen nor Christal teach automatically selecting a form for an outgoing message. Further, Nguyen and Christal do not teach selecting a form for an outgoing *electronic mail* message as discussed in regard to Group II. The Examiner has failed to identify any part of Nguyen or Christal that teach the use of electronic mail type messages. Therefore, Nguyen in view of Christal does not teach each of the elements of claims 41 and 55. This Group is separately patentable at least because it combines the elements of automatic form selection, use of an electronic mail form, and initiating a response upon detecting predetermined contact. None of these elements are obvious over Nguyen in view of Christal for the reasons discussed above and Groups I, II and III do not include each of these elements in combination. Accordingly, these claims are separately patentable and it is requested that the obviousness rejection of Group VI be overturned.

H. **Rejection of Group VII under 35 U.S.C § 103(a) as Obvious over  
Nguyen in View of Christal**

With respect to Group VII, the Examiner has failed to establish a *prima facie* case of obviousness. In regard to claims 43, 46 and 49, these claims depend from independent claims 35, 44 and 47 and incorporate the limitations thereof. Thus, at least for the reasons mentioned in regard to claims 35, 44 and 47, these claims are not obvious over the Nguyen in view of Christal. Further, claims 43, 46 and 49 are separately patentable for the following reasons.

Claims 43, 46 and 49 include the elements that a "form is preconfigured to include a destination address." The Examiner has failed to identify any part of Nguyen or Christal that teaches or suggests the use of forms that are preconfigured. The Examiner has not identified any part of Nguyen or Christal teaches the use of forms to be used for reply messages. In addition, the Examiner has not identified any part of Nguyen or Christal that teaches preconfiguring forms to include a destination address. Nguyen in view of Christal does not teach each of the elements of claims 43, 46 and 49. Thus, the Examiner has failed to establish a *prima facie* case of obviousness. Further, these claims are separately patentable because the claims of Group I do not claim the used preconfigured forms which a user can associate with certain set of conditions or senders. These preconfigured forms can then be appropriately selected in response to initiating a transmission mode based on displayed information. This gives the user greater flexibility in messaging and speeds up the message writing process. See specification of Appellants, page 14, lines 3-16. Accordingly, these claims are separately patentable and it is requested that the obviousness rejection of Group VII be overturned.

I. **Rejection of Groups I-VIII under Obviousness Type Double Patenting Doctrine**

To establish a *prima facie* case of non-statutory type double patenting, the Examiner must show that any variation between the invention in the claims under consideration and the issued patent claims would have been obvious to one of ordinary skill in the art. In *Re Goodman*, 11 F3d 1046, 1052 29 USPQ 2d 2010, 2015-16 (Fed. Cir. 1993) ("If one claimed invention has a broader scope than the other, the court must proceed to a second inquiry; whether one claim defines merely a variation of the other part of claim ...").

In regard to independent claims 35, 44, 47-56, Appellants note that the Examiner has not identified where in the claims of Wagner '911 the automatic selection of a form for a message to be transmitted based on the content of displayed information is claimed. Rather, Wagner '911 claims automatically selecting and displaying a reply form in response to user input. See claim 11 of



Wagner '911. Thus claims 35, 44, 47 and 56, dependent claims 36, 37, 43, 45, 46, 48 and 49 are patentably distinct from claims 1-14 of Wagner '911. In regard to claims 38 and 53, the Examiner mischaracterizes the claims of Wagner '911 as teaching "entering an automatic reply mode such as an email reply mode or a voice reply mode based on a source identifier and the received message." However, the claims of Wagner '911 in fact claim entering a reply mode based on user input. See claim 1, lines 16-20, claim 3, lines 11-13, claim 6, lines 22-25, claim 7, lines 91-22, claim 8, lines 10-15, claim 12, lines 12-17 and claim 14, lines 12-18. In each of these claims, Wagner '911 teaches that once the reply mode has been entered based upon user input that either electronic mail mode or a voice reply mode is selected based on a source identifier. Thus, a source identifier chooses between modes but does not initiate the entering of the mode as claimed in claims 38 and 53 and thus dependent claims 40-42, 54 and 55. Accordingly, it is requested that the obviousness type double patenting rejection of claims 35-49, and 53-56 be overturned.

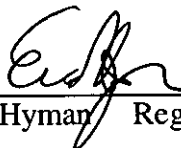
**IX. CONCLUSION AND RELIEF**

Accordingly, it is submitted that the rejections based on 35 U.S.C. §103 and the obviousness type double patenting rejection be overturned.

Respectfully submitted,

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**CERTIFICATE OF MAILING:**

I hereby certify that this correspondence is being deposited as First Class Mail with the United States Postal Service in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on October 4, 2002.

  
Lillian E. Rodriguez

10-4-02  
October 4, 2002

## **X. APPENDIX**

The claims involved in this Appeal are as follows:

1           35.     A method of allowing a user to transmit a message in a portable telephone, the  
2 portable telephone including a display device, the method comprising the steps of:

3                 receiving previously requested data from a remote source;  
4                 displaying information representative of the previously requested data on the display  
5 device;

6                 in response to a user input initiating a transmission mode, automatically selecting a form for  
7 a message to be transmitted based on a content of the displayed information at the time the user  
8 input is received.

1           36.     A method according to claim 35, wherein the portable telephone is configured to  
2 send and receive electronic mail messages; and

3                 wherein the step of automatically selecting a form for a message to be transmitted  
4 comprises the step of automatically selecting a form for an outgoing electronic mail message based  
5 on a content of the displayed information at the time the user input is received.

1           37.     A method of enabling a portable telephone to allow a user to transmit a message, the  
2 method comprising the step of transmitting sequences of instructions from a host processing  
3 system to the portable telephone, the sequences of instructions including instructions which, when  
4 executed on the portable telephone, cause the portable telephone to perform the method recited in  
5 claim 35.

1           38.     (Amended) A machine-implemented method of allowing a user to transmit a  
2 message in a portable telephone, the method comprising the steps of:

3                 receiving data from a remote source;  
4                 monitoring the content of the data for predetermined content; and

5                 in response to detecting the predetermined content, automatically entering a mode for  
6 allowing a user to transmit a message from the telephone.

1           39.    (Amended) A machine-implemented method according to claim 38, wherein the  
2 step of automatically entering a mode for allowing a user to transmit a message from the telephone  
3 comprises the step of automatically selecting a message to be transmitted in response to detecting  
4 the predetermined content.

1           40.    (Amended) A machine-implemented method according to claim 38, wherein the  
2 step of automatically entering a mode for allowing a user to transmit a message from the telephone  
3 comprises the step of automatically selecting a format of a message to be transmitted in response to  
4 detecting the predetermined content.

1           41.    (Amended) A machine-implemented method according to claim 40, wherein the  
2 telephone is configured to send and receive electronic mail messages and to display received  
3 electronic mail messages to a user; and

4           wherein the step of automatically selecting a format of a message to be transmitted  
5 comprises the step of automatically selecting a form for an outgoing electronic mail message in  
6 response to detecting the predetermined content.

1           42.    A method of enabling a portable telephone to allow a user to transmit a message, the  
2 method comprising the step of transmitting sequences of instructions from a host processing  
3 system to the portable telephone, the sequences of instructions including instructions which, when  
4 executed on the portable telephone, cause the portable telephone to perform the method recited in  
5 claim 38.

1           43.    A method according to claim 36, wherein the form is pre-configured to include a  
2 destination address.

3           44.    A portable telephone comprising:  
4           a display device  
5           means for receiving previously requested data from a remote source;  
6           means for causing information representative of the previously requested data to be  
7 displayed on the display device;

means, responsive to a user input initiating a transmission mode, for automatically selecting a form for a message to be transmitted based on a content of the displayed information at the time the user input is received.

45. A portable telephone according to claim 44, wherein the portable telephone is configured to send and receive electronic mail messages; and

wherein the means for automatically selecting a form for a message to be transmitted comprises means for automatically selecting a form for an outgoing electronic mail message based on a content of the displayed information at the time the user input is received.

46. A method according to claim 45, wherein the form is pre-configured to include a destination address.

47. A portable telephone comprising:

an input device;

a display device;

a transceiver configured to receive a communication from a remote source over a wireless link; and

a control circuit coupled to the display device and the receiver, the control circuit configured to cause information representative of the communication to be displayed on the display device, the control circuit further configured to detect a user input at the input device initiating a transmission mode, and further configured to respond to the user input by selecting a form for a message to be transmitted based on a content of the displayed information at the time the user input is received.

48. A portable telephone according to claim 47, wherein the transceiver is configured to send and receive electronic mail messages over the wireless link; and

wherein the control circuitry is configured to automatically select a form for an outgoing electronic mail message based on a content of the displayed information at the time the user input is received.

49. A portable telephone according to claim 48, wherein the form is pre-configured to include a destination address.

1           53.     A portable telephone comprising:

2           means for carrying out a two-way telephone communication over a wireless link

3           means for receiving non-voice data from a remote source;

4           means for monitoring the content of the data for predetermined content; and

5           means, responsive to detecting the predetermined content, for automatically entering a

6 transmission mode for allowing a user to transmit an electronic mail message from the telephone.

1           54.     A portable telephone according to claim 53, wherein the means for automatically

2 entering a mode for allowing a user to transmit an electronic mail message from the telephone

3 comprises means for automatically selecting a message to be transmitted in response to detecting

4 the predetermined content.

1           55.     A portable telephone according to claim 54, wherein the means for automatically

2 entering a mode for allowing a user to transmit an electronic mail message from the telephone

3 comprises means for automatically selecting a format of a message to be transmitted in response to

4 detecting the predetermined content.

1           56.     A portable telephone communication device comprising:

2           a display device

3           a transceiver configured to carry out a two-way telephone communication and further

4 configured to receive non-voice data from a remote source;

5           a control circuit coupled to the transceiver and the display device, the control circuit

6 configured to detect predetermined content in the non-voice data, to enter a transmission mode for

7 allowing a user to transmit an electronic mail message in response to detecting the predetermined

8 content, and to automatically select a message to be transmitted in response to detecting the

9 predetermined content.